

02 OCT 2006



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In re Application of	:	DECISION ON
MORDAUNT et al	:	
Int. Application: PCT/US2003/029132	:	
Application No.: 10/531,691	:	REQUEST UNDER
Int. Filing Date: 16 October 2003	:	
Priority Date: 17 October 2002	:	
Attorney's Docket No.: P-5458-US	:	
For: SYSTEM, MEHOD... WAVELENGTHS	:	37 CFR 1.497(d)

This is a decision on petitioner's "PETITION TO ADD AN INVENTOR UNDER 37 CFR 1.48(a)" filed on 06 June 2006, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Daniel Gat in the executed declaration. A petition fee of \$130.00 as been charged to petitioner's Deposit Account No. 50-3355 as authorized in the petition.

**BACKGROUND**

On 16 October 2003, applicants filed international application No. PCT/US2003/029132 and claiming a priority date of 17 October 2002.

On 18 April 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee, but no executed declaration was submitted at such time.

On 22 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or declaration of the inventors, in compliance with 37 CFR 1.47(a) and (b), identifying the application by International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. The notice also indicated that the items set forth above must be submitted within two (2) months from date of this Notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 22 February 2006, applicants filed, inter alia, an executed declaration and listed DEWEY, David A. as a co-inventor, who was not listed, who was not listed in the international application.

On 15 May 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) indicating that Mr. David Dewey is an added inventor whose name is not published in the international application.

On 06 June 2006, applicants filed a "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS," which included, *inter alia*, a statement under 37 CFR.1.497(d) adding co-joint inventor David Dewey in the executed declaration.

### **DISCUSSION**

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (2) - (3) under 37 CFR 1.497(d), but not item (1).

With respect to item (1), the statement submitted on 14 June 2006 by David Dewey is sufficient because the statements state that the error in inventorship occurred without a deceptive intent in the national stage application. However, the executed declaration filed on 06 June 2006 is defective and, for the reason below, the application may not enter into national stage processing at this time. It does not comply with 37 CFR 1.497(a)(3). A Declaration, under 37 CFR 1.497(a)(3), must identify each inventor. See MPEP § 602. In this instance, applicants submitted a composite declaration comprising of two sets of declarations, which one is incomplete because each set must be complete by having the correct number of pages and listing all the inventors. In this case only, one set is complete because it comprises of the three (3) pages of the declaration. The other set is incomplete because it only contains page 3 (without Mr. Dewey listed on it) and it does not have other pages of the Declaration to make it complete. Therefore the composite Declaration is incomplete.

Copies of the same page is not part of a proper declaration since it is considered a composite declaration and each must be a complete declaration with the proper statement and the names of each inventor even though each set of declarations may not have all the signatures of the inventors. Therefore, a proper declaration must consist of individual complete sets of declaration that taken as a whole would have all the required signatures as required under 37 CFR 1.497(a)(3).

With respect to item (2), the processing fee of \$130.00 has been charged to the Deposit Account No.: 50-3355.

With respect to item (3), Lumenis, Inc., the assignee, consents to the correction of inventorship to the above application and it has filed in the requisite papers establishing its right to take action under 37 CFR §3.73(b), since the assignment has been recorded in USPTO at Reel/Frame 017703/0701.

Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

### **CONCLUSION**

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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